



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,465	01/04/2001	William J. Gray	10655.9900	3628
7590	11/17/2003			EXAMINER HEWITT II, CALVIN L
Howard I. Sobelman Snell & Wilmer L.L.P. One Arizona Center 400 E. Van Buren Phoenix, AZ 85004-2202			ART UNIT 3621	PAPER NUMBER
DATE MAILED: 11/17/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/754,465	GRAY ET AL.
	Examiner Calvin L Hewitt II	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 January 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4 and 5</u> . | 6) <input type="checkbox"/> Other: _____ . |

Status of Claims

1. Claims 1-38 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 12, 17, and 22 recite "said forms comprising said security processor authorization". To one of ordinary skill this means the authorization is present in the form. This feature is not supported by the Specification (Specification, page 10, lines 25-30; page 11, lines 5-9 and 16-28).

Claims 2-5, 13-16, 18-21 and 23-26 are also rejected as they depend from claims 1, 12, 17 and 22 are also rejected as they depend from claims 1, 12, 17 and 22 respectively.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 and 12-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claims 1, 12, 17 and 22 recite the limitation "said security processor authorization" in sections 1f, 12e, 17e and 22e. There is insufficient antecedent basis for this limitation in the claim.

Claims 2-5, 13-16, 18-21 and 23-26 are also rejected as they depend from claims 1, 12, 17, and 22 respectively.

Claims 28 and 36 recite the limitation "instrument" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "said merchant" in line 3. There is insufficient antecedent basis for this limitation in the claim.

7. The term "incident" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "incident" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Webster's Ninth New Collegiate Dictionary defines "incident" as "occurring or likely to occur" and as a "minor consequence or accompaniment". It

is not clear to one of ordinary skill how a form is "incident" to a transaction (claim 1) or merchant (claim 12).

Claims 2-6 and 13-16 are also rejected as they depend from claims 1 and 12, respectively.

8. Claims 27, 31 and 35 recites an interface "operative to permit validation of said form". However, the interface does not receive the form.

Claims 28-30, 32-34 and 36-38 are also rejected as they depend from claims 27, 31 and 35 respectively.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5, 12-26, and 27-38 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Daly et al., U.S. Patent No. 5,878,141.

As per claims 1-5 and 12-26 Daly et al. teach a method for conducting electronic transactions (figure 1) comprising:

- an authentication server receiving a request to authenticate a transaction from a user at a server (figure 6)
- requiring the user to provide an instrument (e.g. smart card) for verification, receiving an instrument input in response, processing said instrument input as input to a security processor (figure 1; column 5, lines 45-55; column 6, lines 36-55; column/line 8/62-9/7)
- assembling forms for the transaction, said forms comprising said security processor authorization of said input to said security processor (figure 5)
- authorizing the forms twice at a security processor (column 7, lines 5-17; column 8, lines 20-61)
- validating the transaction with the second authorization (column 8, lines 47-61)
- providing transaction validation for different combinations of instruments and security processors without requiring changes to transaction processing by said merchant (figure 1)
- a digital wallet (column/line 2/64-3/6; column 8, lines 12-20)

As per claims 27-38, Gifford teaches a transaction system operative to provide validation for different combinations of instruments and processors (figure 1; column 7, lines 48-63; column/line 8/62-9/7) comprising:

- a data network, including an instrument and operative to permit initiation of a transaction (figure 1)
- an authorization server (e.g. electronic purchase server) coupled to receive said initiation as input and transmit same to a security server (column 7, lines 8-17)
- a security server receives the data from the authorization server and generates and transmits an authorization form to said authorization server, and an interface coupled to the security server and operative to permit validation of said form and complete a secure online virtual transaction (column 8, lines 47-61)
- an electronic purchase server coupled to a digital wallet and operative to validate transaction input transmitted to said security server

11. Claims 6 and 8-11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gifford, U.S. Patent No. 6,049,785.

As per claims 6 and 8-11, Gifford teaches a method for performing electronic transactions comprising: developing a first query for transmission to a credit provider, selected from a group of credit providers, receiving a response

from said credit provider and transmitting same to said merchant, said merchant querying said credit provider for authentication of said credit provider for authentication of said credit provider response; and completing said virtual transaction using authorization from said credit provider (figure 12; column 7, lines 55-61). Gifford also teaches developing a form from a response from a credit provider and sending the form to a merchant (figure 12), requesting authentication of the form from the credit provider (column 7, lines 55-61).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, U.S. Patent No. 6,049,785.

As per claim 7, Gifford teaches the use of smart card (column/line 10/51-11/3). Therefore, it would have been obvious to open a wallet and input a smart card in order to authenticate a transaction (column 10, lines 23-26).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Chen et al. teach secure online transactions comprising a smart card and a credit provider specific digital wallet
- Tognazzini teaches online transactions with a smart card for storing digital receipts
- Teicher teaches electronic wallets

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II
November 12, 2003

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600